

## REMARKS

This Response is submitted in reply to the non-final Office Action dated June 29, 2007, issued in connection with the above-identified application. Presently, claims 1, 2, 5 and 7-13 are pending in the present application. With this Response, independent claims 1 and 7-9 have been amended. No new matter has been introduced by this Response. Entry of the amendments and favorable reconsideration is respectfully requested.

Claims 1, 2, 5 and 7-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Estrada et al.* (U.S. Patent No. 6,732,148) in view of *Hatlelid et al.* (U.S. Patent No. 6,772,195) and *Bunney* (U.S. Patent No. 6,446,112). The Applicants respectfully traverse these rejections.

Applicant has clarified that the present claims are directed to “maintaining a user space within the virtual space, wherein the user space comprises spatial locations that virtually represent physical areas owned and occupied by a first user, and wherein the first user controls admission of other users within the user space for chat sessions with the first user” and “storing the user space, a list of spatial locations and at least one list of users associated with a chat session within the user space, wherein said list of users is generated by the first user and includes at least one other user denied admission to the user space and at least one other user granted admission to the user space.”

Previously, the claims were distinguished in the fact that the cited references failed to disclose storing at least one list of users associated with a chat session within the user space, wherein the list of users is generated by the first user and includes at least one second user denied admission to the user space and at least one second user granted admission to the user space (see Applicants’ Application, Fig. 6). Thus, a user is either denied or granted access to the chat session based on his or her presence on the list. Under the present amendments, Applicant has further clarified that the apparatus/method/computer program is directed to a virtual space that is related to a “virtual world” instead of a rendered web page (such as the one disclosed in Estrada).

As argued previously, Estrada discloses a system and method for interconnecting secure rooms for allowing users to collaborate on a common work product. For example, users having access authorization (e.g., read, edit and manage) can access a common room, wherein each room is made up of a plurality of pages (col. 5, lines 60-65). Each user, having the appropriate

access, can collaborate in reading, editing and managing the pages in the room. Applicant notes that the context of a “room” as disclosed by Estrada relates to individual web page forms related to a collaborative space (col. 17, line 55 - col. 18, line 11). Thus, users navigating rooms must do so via web form templates (see col. 21, lines 14-30) - Estrada fails to teach or suggest that the user space comprises spatial locations that virtually represent physical areas owned and occupied by a first user. While Estrada implements a form of access security to the room (e.g., read, edit and manage), the access security is not related to a list of users participating in a virtual chat session. Additionally, as correctly noted by the Examiner, Estrada also fails to disclose the claimed “notifying means,” “determining means” and “control means” of the present invention. (see Office Action, page 3).

Hatlelid fails to overcome all the deficiencies noted above in Estrada. For example, although Hatlelid discloses the use of chat clusters in a virtual world, the reference fails to disclose the use of *a list of users associated with a chat session within the user space for granting or denying access to the chat session*. In fact, at best, Hatlelid discloses a real-time notification and permission system for granting or denying access to a chat session. (see Hatlelid, col. 7, lines 18-56). It should be noted that the permission process is a binary determination - in other words, a user may ask permission to join, and the user(s) may simply reply “yes” or “no.” If permission is first denied, Hatlelid appears to allow a requesting user to simply repeat the request over and over in relation to a chat cluster. Additionally, the process for expanding users in Hatlelid bears no relation to a list of users and their respective status. As col. 7, lines 38-56 explains, added users only affect the number of participants, and their respective position to a locus of the conversation area.

Regarding Bunney (and mIRC notes), the documents merely disclose the management of access control databases to establish a ban list related to an IRC service (Bunney, col. 2, lines 1-3; mIRC 02/03/95, no. 9). However, none of these documents disclose a user space within the virtual space, wherein the user space comprises spatial locations that virtually represent physical areas owned and occupied by a first user, and wherein the first user controls admission of other users within the user space for chat sessions with the first user. Therefore, even if it were proper for one of ordinary skill in the art to combine the teachings of Estrada, Hatlelid, and Bunney, the

combination still would not teach or suggest all the features recited in claims 1 and 7-9 (as amended).

Additionally, there is no apparent reason why one of ordinary skill and creativity in the art would combine the references in the manner suggested in the Office Action. “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int'l Co. v. Teleflex Inc.* 550 U.S. \_\_\_\_ (2007) (slip op. at 14). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). It is “impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention” *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). “A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments relying on *ex post* reasoning.” *KSR v. Teleflex*, at 17.

In Estrada, the collaborative environment does not relate to IRC technology. While Estrada acknowledges the existence of Internet chat in the Background (col. 1, line 59), there appears to be no other related disclosure anywhere in Estrada that pertains to the collaborative rooms. As explained above, Estrada relies on independently rendered web pages for establishing a room for collaboration. Thus, there would be no reason to involve an IRC server, as required in Bunney and the mIRC document. For at least these reasons, independent claims 1 and 7-9 are distinguished over the cited references. Likewise, dependent claims 2, 5 and 10-13 are distinguished over the cited prior references based on their respective dependencies from independent claims 1 and 9.

In light of the above, the Applicants submit that claims 1, 2, 5 and 7-13 are patentable over the prior art of record. Accordingly, the Applicants respectfully request that a timely Notice of Allowance be issued in this case.

If any additional fees are due in connection with this application as a whole, the Director is authorized to deduct such fees from deposit account no. 02-1818.

Respectfully submitted,

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